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U.S. Supreme Court
FILED
APR 24 1945
CHARLES ELMORE DROPLEY
CLERK

Supreme Court of the United States
OCTOBER TERM, 1944

No. 1100

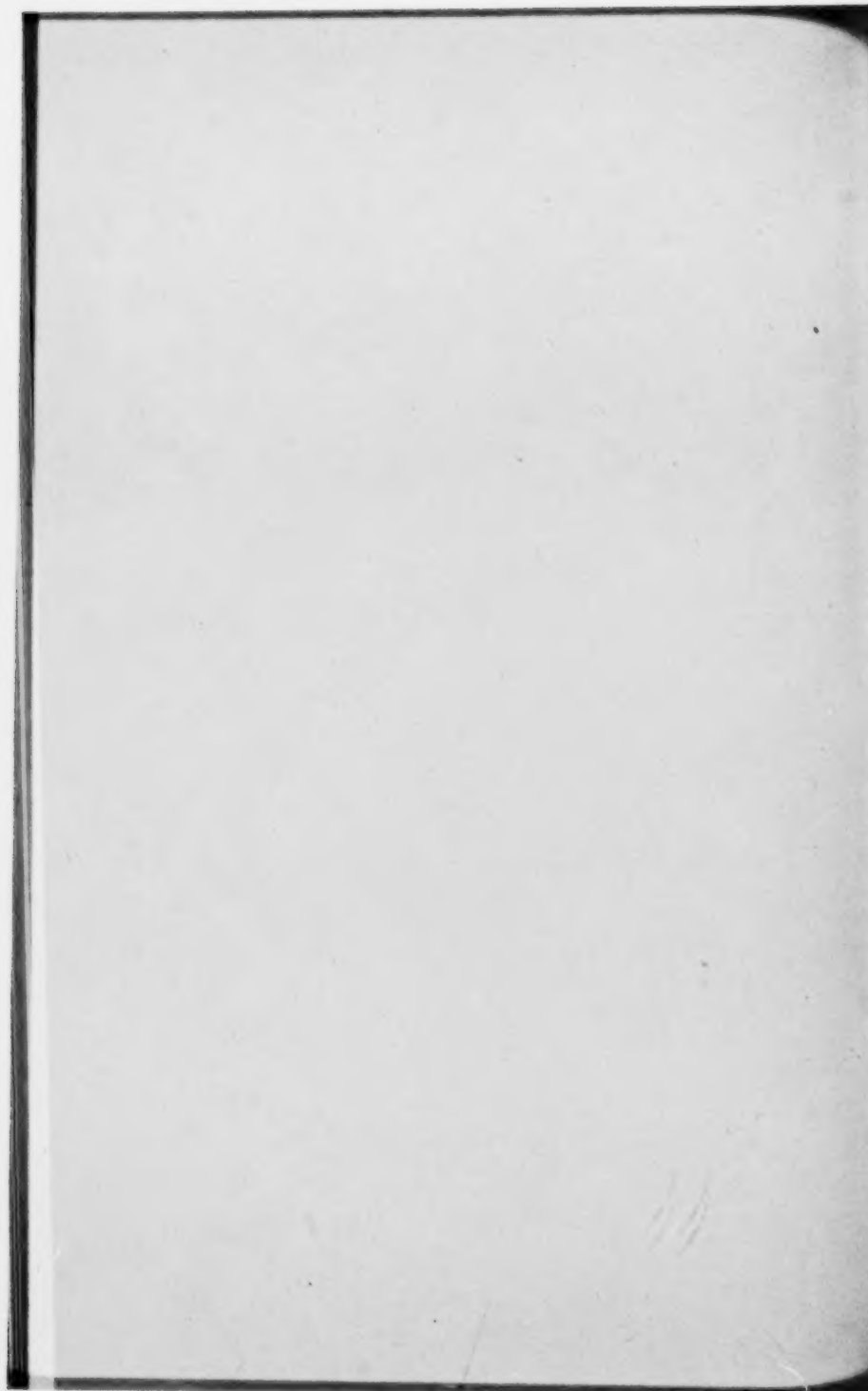
RICHARD A. ENGLER, *Petitioner,*
v.

GENERAL ELECTRIC COMPANY, *Respondent.*

RESPONDENT'S BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI

ALEXANDER C. NEAVE,
Counsel for Respondent.

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In this case the District Court and the Court of Appeals for the Second Circuit concurred in holding that the patent in suit was not infringed. Neither court found it necessary to pass upon the defense of invalidity.

There is no conflict of decision: this is the only suit upon this patent, which expired during the litigation.

There is no important question of law and no conflict of law: the courts below applied the well-known principles of patent law and both courts found no infringement.

There is no question of commercial importance: the alleged infringement consisted of only one machine made by respondent, and as admitted in the petitioner's brief (p. 5) petitioner never built his patented machine.

Neither the petition nor the supporting brief sets forth any reason for review by this Court other than that neither of the courts below would accept petitioner's argument of infringement based upon the doctrine of equivalency. That

is an insufficient basis for the granting of a writ of certiorari. In *Magnum Import Company, Inc. v. Coty*, 262 U. S. 159, 163, Mr. Justice Taft stated:

“The jurisdiction [to bring up cases by certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing.”

It is evident from the opinions below that both courts considered the petitioner's patent with great care to determine the invention there disclosed and claimed, and concluded unanimously that the invention, if any, was not to be found in respondent's device. If any invention at all was made, it resided in reversing the polarity of the rotor magnet of the device and in stifling certain unwanted voltages caused by these reversals. A device which embodied other means for obtaining motor action or which did not produce and stifle these unwanted voltages did not infringe, and could not infringe through the doctrine of equivalents or otherwise, for if those features were not used, nothing of the petitioner's was used. He did not invent motor action, but only suggested a device of specific construction.

This is clearly established by the District Court's Findings of Fact 7 to 13 inclusive:

“7. In all of the eight claims of the Engler patent the dominant and characterizing features of each claim are the reversal of the polarity of the rotor magnet and the rendering ineffective the voltages induced in the armature winding caused by such reversal.

8. There is not found in the Logan Motor [respondent's device] magnetic members of reversible polarity (5), means for reversing the polarity in a synchronous cycle (9), means for rendering ineffective the electromotive force induced by said reversals (10).

9. Plaintiff urged infringement on the ground that the Logan Motor has equivalents of the said

elements 5, 9 and 10; that the Logan Motor reached the same result as the device contemplated by Engler and does it by a combination of elements, each of which is the same or equivalent.

The two devices do accomplish the same result, i.e., cause rotation, which produces electric force or working power but each accomplishes this in a substantially different way.

10. The specification and claims 1 through 8 inclusive of the Engler patent are limited to a particular mode of operation. By this mode of operation, (1) the rotating electric field member of the machine is reversed in polarity every half revolution by means of a commutator 10 mounted on the shaft of the machine, (2) the reversal of the polarity of the rotating field member induces an unwanted and useless voltage in the armature winding, and (3) this voltage caused by the field reversal is rendered ineffective either by short circuiting the armature winding as in Fig. 1, or by open circuiting the armature windings as in Fig. 2 by means of an electromagnetic switch. This is not found in the Logan Motor either specifically or by equivalents.

11. The distinguishing element in the Engler motor as evidenced by claim 8 is a reversal of the polarity of the rotor field magnet; the rotor polarity is reversed every half revolution. There is no such thing in the Logan Motor.

The Logan Motor operates with no reversal of current either in the winding of the armature (stator), or in the winding of the rotating member the rotor. The Engler motor operates because he reverses the current in the field winding in the rotor. This is absolutely essential to the Engler Motor. It is not in the Logan Motor.

12. The cutting out of an armature coil in the Logan motor and cutting it in again a half of a revolution later is not equivalent to the reversal in the Engler machine.

13. There is nothing in the Logan Motor equivalent to elements 5 and 9 of the Engler patent."

The Court of Appeals agreed with these findings, stating (144 F. (2d) 191, 194, 195):

" * * * Both [devices] prevent 'locking'. But there the similarity ends. And when the appellant claimed only a combination which included means for reversing polarity, and it appears that that was the *sine qua non* of his invention, if he made any at all, proof which shows that the defendant constructed an electric motor which ran with no reversal of polarity at all fails to prove infringement."

" * * * That intermittent polarity is not here the equivalent of continuously reversing polarity is made clear by the fact that the latter is a limitation in a patent claim for a device which as disclosed in the specifications must have such continued polarity constantly reversing to operate at all. It is to be taken for granted that the patentee meant what he said when he limited his claims in plain words to that essential feature of his machine. He then made his bargain and now must abide by it. *Ajello v. Pan-American Airways Corp.*, 2 Cir., 128 F. 2d 196. It will not help his cause as he now argues, to say that he might have prevented locking by successively cutting out and cutting in armature coils to make polarity non-existent periodically and so obviate locking by means of intermittent polarity. He did not secure patent claims broad enough to cover generally the prevention of the locking of the field and the armature in an electric motor. That, per se, was not new and accomplishing it in a way like that the appellee employed by cutting out and later cutting in armature coils was itself very old, as the *Leyser's* German Patent No. 23,880, granted in 1883, well shows."

With respect to the so-called "trigger-circuit", the District Court's Finding of Fact 14 was as follows:

"14. There is not present in the Logan Motor either specifically or by equivalence 'means for rendering ineffective the electromotive force induced by said reversals'."

The Court of Appeals agreed with this finding, stating (144 F. 2d 191, 193):

“Neither the so-called trigger circuit nor anything which accomplished the same result is present in the accused motor.”

The District Court found as its Conclusion of Law 4:

“Claims 1 through 8, inclusive, of the Engler patent 1,492,972 are not infringed by defendant’s Logan Motor. These claims cannot be read so broadly as to be infringed on the basis of any proper application of the doctrine of equivalents.”

The Court of Appeals stated (144 F. 2d 191, 195):

“The trial judge was quite right when he held that no infringement of the claims in suit had been shown.”

The Court of Appeals again gave careful consideration to the case on petitioner’s petition for rehearing, which it denied with an opinion reaffirming its decision of non-infringement (146 F. 2d 723).

The case was correctly decided below, both courts concurring in holding that respondent had not infringed the patent in suit. Petitioner has advanced no reason to warrant a review by this Court.

We respectfully submit that the petition should be denied.

ALEXANDER C. NEAVE,
Counsel for Respondent.

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